

REMARKS/ARGUMENTS

The non-final Office Action of January 24, 2008, has been reviewed and these remarks are responsive thereto. Claims 2-6, 8-17, 20-24, 26-31, 33-41, and 43-61 are pending in this application. Reconsideration and allowance of the instant application are respectfully requested.

Rejections Under 35 U.S.C. § 112

Claims 2-6, 8-17, 20-24, 26-31, 33-41, and 43-61 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Applicant respectfully traverses this rejection for at least the following reasons.

Specifically, with respect to independent claims 50, 52, and 53, the Office Action states on page 2:

It is unclear, however, where the request is sent to, received from, what device identifies the feature values, what device performs the matching and what device provides content. All of these tasks can be performed on a central information repository, a proxy server, a database, the requesting terminal itself or any terminal in between the requesting device and a device where the content is located.

First, Applicant disagrees that it is unclear where the content request is received from in claims 50, 52, and 53. Claim 50, for example, recites “wherein the device-independent content is responsive to a content request from a network terminal device.” (Emphasis added).

Furthermore, Applicant believes that the Examiner is improperly equating breadth with indefiniteness. See MPEP § 2173.04. Even if all of the steps of claims 50, 52, and 53 can be performed by multiple different types of devices (e.g., a proxy server, a database server, a receiver terminal, etc.), that does not mean that the claims are indefinite, but merely that they are broader than they would be if they recited a limitation to a specific type of device within the communication network. Therefore, by requiring that the claims to be limited to a specific device type, for example, a proxy server, the Office Action is improperly forcing Applicant to

restrict the scope of his claims. Accordingly, Applicant respectfully requests that the rejection under 35 U.S.C. § 112 be reconsidered and withdrawn.

Rejections Under 35 U.S.C. § 102

Claims 2-6, 8-14, 17, 20-24, 26, 29-31, 33-41, 43-45, and 50-61 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,654,814 (Britton). Applicant respectfully traverses this rejection.

Independent claim 50 recites, in part, “device-independent content comprising markup information identifying one or more device feature values.” The Office Action alleges that Britton teaches this feature at Col. 1, lines 45-65, Col. 5, lines 1-8, Col. 8, lines 35-68, and Col. 10, lines 2-62. Applicant respectfully disagrees. The Office Action on page 3 apparently concludes that Britton teaches this feature by arguing that a first portion of Britton teaches “device-independent content comprising markup information,” while a second portion of Britton teaches, “identifying one or more device feature values.” Even assuming, without admitting, that Britton teaches both (1) device-independent markup information, and (2) identifying device features, that does not mean that Britton discloses or even suggests device-independent content including “markup information identifying one or more device feature values,” as recited in claim 50 (Emphasis added). Thus, by unnaturally parsing this claim feature, the Examiner has avoided addressing one of the primary deficiencies of Britton previously noted by the Applicant in the Amendment submitted May 21, 2007.

On page 13 of the Amendment submitted May 21, 2007, Applicant argued that this same feature of claim 50 was not disclosed by Britton. Specifically, the Applicant noted that Britton’s server receives content from a central repository and provides it to a requesting client, tailoring the content based on the client’s device capabilities and user preferences. See FIG. 2; Col. 10, lines 2-23. However, in Britton, the device-independent content, i.e., the content received from the central repository, does not contain any markup information. Thus, even if Britton’s server adds markup information to the content, it would only add device-specific markup information corresponding to the user preferences or device capabilities of the requesting client, thereby making the content device-specific. This distinction is significant. As discussed in the instant application, the use of markup information within device-independent content enables content

authors to customize the rendering of content on different devices, rather than merely relying on user preferences and device capabilities. See, e.g., Specification, page 4, lines 1-4; FIG. 1. Therefore, because Britton does not disclose “device-independent content comprising markup information identifying one or more device feature values,” independent claim 50 is not anticipated by Britton.

Applicant also notes that following the Amendment submitted May 21, 2007, the rejection under 35 U.S.C. § 102(e) based on Britton was withdrawn in the subsequent Office Action dated August 10, 2007.

For the reasons stated above, Applicant submits that even if Britton teaches “device-independent content comprising markup information,” and also teaches, “identifying one or more device feature values,” Britton does not disclose or suggest “device-independent content comprising markup information identifying one or more device feature values,” as recited in claim 50.

Independent claims 51-53, 56, and 58 each recite similar features not disclosed by Britton. Specifically, claims 51 and 56 recite, “device-independent content compris[ing] markup information identifying one or more device feature values associated with the device-independent content,” claim 52 recites, “content compris[ing] markup information identifying one or more content display characteristics,” claim 53 recites, “device-independent content comprising embedded annotations specifying author intent for displaying the content on a plurality of devices having different display characteristics, said embedded annotations including one or more content display feature values,” and claim 58 recites receiving “device-dependent content compris[ing] a modified version of the device-independent content, said modifications based on the type of the apparatus.” Thus, for similar reasons to those discussed in reference to claim 50, independent claims 51-53, 56 and 58 are also not anticipated by Britton.

Additionally, independent claim 52 recites wherein “said content display characteristics expressing an author intent for displaying said content on a plurality of devices having different display characteristics,” and independent claim 53 recites wherein “the device-independent content comprising embedded annotations specifying author intent for displaying the content on a plurality of devices having different display characteristics.” (Emphasis added) As argued previously in the Amendment submitted May 21, 2007, Britton only tailors information based on

user preferences and device capabilities, it does not disclose customizing the rendering of content on different devices based on author intent, as recited in claims 52 and 53. The Office Action alleges that author intent is shown in Britton at Col. 9, lines 55-60, and Col. 11, line 61 to Col. 12, line 24. However, the relied-upon portions of Britton only relate to rules, policies, and preferences of the user receiving the content (i.e., the device user), and do not disclose or suggest an author intent for displaying said content on a plurality of devices having different display characteristics. Accordingly, independent claims 52 and 53 are allowable for at least these additional reasons.

Claims 2-6, 8-14, 17, 20-24, 26, 29-31, 33-41, 43-45, 57, and 59-61 each depend from one of claims 50-53, 56, or 58 and are allowable for at least the same reasons as their respective base claim, as well as based on the additional features recited therein. For example, claims 8 and 9 respectively recite, “invoking said markup information corresponding to the device feature values,” and “removing said markup information from said device-independent content.” The Office Action alleges that these features are taught by Britton at Col. 8, lines 26-37 and Col. 12, lines 20-31. However, as previously argued in the Amendment submitted May 21, 2007, neither the relied-upon sections nor any other section of Britton discloses converting device-independent content by invoking or removing markup language. Thus, Britton does not disclose “invoking said markup information corresponding to the device feature values,” or “removing said markup information from said device-independent content,” as recited in claims 8 and 9. Accordingly, Applicant submits that dependent claims 8 and 9 are allowable for at least this additional reason.

Rejections Under 35 U.S.C. § 103

Claims 15, 27-28, and 46-49 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Britton in view of U.S. Patent Publ. No. 2002/0091738 (Rohrabaugh). Claim 16 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Britton, in view of Rohrabaugh, and further in view of U.S. Patent No. 6,523,040 (Lo). However, neither Rohrabaugh nor Lo cures the deficiencies of Britton discussed above in relation to independent claims 50-53. Thus, claims 15-16, 27-28, and 46-49 are allowable for at least the same reasons as their respective base claims, as well as based on the additional features recited therein.

Claim 54 and 55

Although the Office Action Summary indicates that claims 54 and 55 stand rejected, the Office Action did not include a substantive rejection of these claims based on any of the cited references. Applicant has previously argued, on page 16 of the Amendment filed May 21, 2007, that the features of claims 54 and 55 are neither taught nor suggested by Britton, Rohrbaugh, or Lo, alone or in combination. The Applicant continues to believe that these claims are allowable over the cited references. Additionally, because the Office Action has not indicated where in the cited references features of claims 54 and 55 are allegedly taught, Applicant respectfully requests that a subsequent office action that substantively addresses these claims should also be non-final to provide Applicant an opportunity to respond to such rejections when first presented.

CONCLUSION

Based on the foregoing, Applicant respectfully submits that the application is in condition for allowance and a Notice to that effect is earnestly solicited. Should the Examiner believe that anything further is desirable in order to place the application in even better form for allowance, the Examiner is respectfully urged to contact Applicant's undersigned representative at the below-listed number.

Respectfully submitted,
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